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ARNOLD & PORTER LLP  
ATTN: IP DOCKETING DEPT.  
555 TWELFTH STREET, N.W.  
WASHINGTON DC 20004-1206

In re Application of :  
Kremer et al. :  
Application No. 10/563,956 :  
Filing Date: 10 January 2006 :  
Atty. Docket No.: 18724.009 : DECISION  
For: Autologous Self-Tolerance Inducing :  
Cells Of Monocytic Origin And Their :  
Use In Pharmaceutical Preparations :

This is in response to the correspondence filed on 10 June 2008, which is a copy of correspondence filed on 15 September 2006.

### **BACKGROUND**

International application PCT/EP2004/000109 was filed on 09 January 2004, claimed an earlier priority date of 11 July 2003, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 30 January 2005. The 30 month time period for paying the basic national fee in the United States expired at midnight on 11 January 2006. Applicants filed, *inter alia*, a basic national fee on 10 January 2006.

On 16 May 2006, a Notice of Acceptance (Form PCT/DO/EO/903) was mailed to counsel, indicating a 35 U.S.C. 371(c)(1), (2) and (4) date of "01/10/2006." A filing receipt was mailed on the same date.

On 20 June 2006, applicants filed a "Request For Corrected Filing Receipt" requesting the addition of data pertaining to U.S. application 10/520,931 and German application 102 31655.4.

On 29 August 2006, a filing receipt was mailed to applicants, showing German application 102 31655.4 under "Foreign Applications."

### **DISCUSSION**

Counsel requests correction of the filing receipt to reflect a domestic priority claim to 10/520,931. Review of the record reveals that the correspondence filed on 10 January 2006 included a preliminary amendment to the specification which, *inter alia*, added a reference to 10/520,931. Further inspection of this preliminary amendment reveals that it states that "This national phase application is a continuation application of International Application No. PCT/EP2004/00109..." Thus, the preliminary amendment characterized this application both as a "national phase" and as a "continuation" of PCT/EP2004/000109. See MPEP 1895, 201.11(a).

The USPTO has adopted a bright-line test for determining whether application papers will be processed under 35 U.S.C. 371 or alternatively under 35 U.S.C. 111(a). Under this standard, any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

- 1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or
- 2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application.

If there are any conflicting instructions as to which section of the statute (371 or 111(a)) is intended the application will be accepted under 35 U.S.C. 111(a).

Inspection of the correspondence filed on 10 January 2006 reveals that the Transmittal Letter indicated that treatment as the national stage under 35 U.S.C. 371 of PCT/EP2004/000109 was desired. However, as noted above, the preliminary amendment filed on 10 January 2006 referred to this application as a "continuation application" of PCT/EP2004/000109, implying that treatment under 35 U.S.C. 111(a) was desired. *See* MPEP 1895, 201.11(a).

These indicia constitute conflicting instructions as to whether processing under 35 U.S.C. 371 rather than U.S.C. 111(a) was desired. Under the policy referenced above, this application properly should have been processed under 35 U.S.C. 111(a). Since applicants have not shown sufficient cause (e.g., loss of rights) or lack of availability of an alternative remedy, it would be appropriate, and consistent with the policy considerations described above, to process this application under 35 U.S.C. 111(a).

The Notice of Acceptance (Form PCT/DO/EO/903) mailed on 16 May 2006 is hereby **VACATED**.

### **DECISION**

The request is **ACCEPTED**, to the extent noted herein.

This application will be returned to the Office of Patent Application Processing for processing as an application filed under 35 U.S.C. 111(a). This processing will include (1) the removal from the application file of the documents transmitted by the International Bureau to the U.S. Designated/Elected Office (DO/EO/US); (2) the correction of the electronic records of the USPTO to show the correct status as an application filed under 35 U.S.C. 111(a) and to accurately reflect the priority claims made in the application; and (3) in due course, the issuance of a corrected filing receipt reflecting, *inter alia*, the reference to 10/520,931.

No response to this Decision is required. In the event that applicants wish to file a response, any such response must be filed within **TWO (2) MONTHS** of the mailing date of this decision, extendable under 37 CFR 1.136(a).

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

/George Dombroske/  
George Dombroske  
PCT Legal Examiner  
Office of PCT Legal Administration  
Tel: (571) 272-3283  
Fax: (571) 273-0459